UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 May 2008*.

2a)☐ This action is **FINAL**.　　　　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 - 4, 6 - 23, and 25 - 39* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 - 4, 6 - 23, and 25 - 39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1 - 4, 6 - 23, and 25 - 39 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claim 29 is objected to because of the following informalities: claim 29 depends on

canceled claim 24. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

- Claims 1 - 4, 6 - 23, and 25 - 39 are rejected under 35 U.S.C. 103(a) as being

  unpatentable over Malik et al. (US 7,133,898), and further in view of Adkins et

  al. (US 2004/0243844).

Regarding claim 1, 7 – 10, 20, 26 - 29, and 39 Malik teaches a method of displaying e-mail: **[Fig. 8, Ref # 810];** maintaining a list of identities associated with a user, **[Prior to presenting the e-mails to the user, the client sorts the e-mail into classifications based upon whether the e-mail is from a personal contact, (Abstract) & (Fig. 4)];** Malik differs from the claimed invention is that determining that an entity is associated with the user based on positive user actions related to e-mail communications with the entity;

Adkins et al. teaches an authorized email control system receives email destined for a particular user.

Adkins et al. further teaches determining that an entity is associated with the user based at least in part, on the positive user actions related to e-mail communications with the entity, **[adding said e-mail message's sender to an accepted sender list if said truncated email body passes all of said at least one filter means, wherein if the sender's actions are positive then the senders email will pass the filter and be added to the list, (Page 11, claim 20)];**

Sheldon et al. further teaches adding the entity to the maintained list when the entity is determined to be associated with the user based, at least in part, on the positive actions related to the e-mail communications with the entity, **[adding said e-mail message's sender to an accepted sender list if said truncated email body passes all of said at least one filter means, wherein if the sender's actions are positive then the senders email will pass the filter and be added to the list, (Page 11, claim 20)];**

Malik further teaches receiving one or more e-mails directed to the user, [**E-mail is**

received at the e-mail server and periodically downloaded upon request from the

e-mail client, (Column 1, lines 55 – 60) & (Fig. 8, Ref # 810)];

identifying senders of the received e-mail, [**The vendor registration code is a string**

of characters used to identify e-mail from the particular e-mail source, (Column 6,

lines 45 – 50) & (Fig. 6, Ref # 814)];

comparing the identified senders to the maintained list of people associated with the

user to determine which of the senders are included on the list, [**Fig. 7, Ref # 714, it is**

determined whether the username and source identify a contact of the particular

user];

displaying a list of the e-mail to the user, [**Fig. 8, Ref # 810]**;

sorting the displayed list based on which of the senders are included in the list, [**Fig. 8,**

Ref # 812 & 814];

Regarding claim 7 & 26, Adkins teaches the method wherein the positive actions

include replying to, forwarding, saving, or printing an e-mail received from the entity,

[**with the practical exceptions of confirmed automated systems such as mailing**

lists, MAILER-DEAMONS, and reply-to addresses in the user's address book,

wherein if the entity is known to the user based on positive actions, and added to

the list then a reply message is sent to the entity, (Paragraph 0080) and

(Paragraph 0053)].

Regarding claim 8 & 27, Adkins teaches the method wherein the positive actions

include moving an e-mail from a first folder to a second folder, [**Fig. 6, Ref # 601, 603,**

wherein the message is moved from receiving box to a mailbox if the sender is on

the address book based on positive actions].

Regarding claim 9 & 28, Adkins teaches the method wherein the first folder is an inbox

folder and the second folder is a folder other than a delete folder or a spam folder, **[Fig.**

6, Ref # 601 & 603, wherein 601 is an inbox that just received the message, and

603 is the main mailbox].

Regarding claim 10 & 29, Adkins teaches the method wherein the positive action

includes leaving an e-mail from the entity open for a predetermined period of time, **[A**

user attempting to inspect the contents of an "exclusive to" interesting sender's

message can be warned that the message is "unacceptable", why, that it is very

likely "spam", and that they are strongly advised NOT to open it unless they

recognize the senders email address, (Paragraph 0176)].

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to modify Malik by including that determining that an entity is associated with

the user based at least in part, on the positive user actions related to e-mail

communications with the entity as taught by Sheldon.

One of ordinary skill in the art would have been motivated to make this modification in

order provide the advantage of adding said e-mail message's sender to an accepted

sender list if said truncated email body passes all of said at least one filter means,

wherein if the sender's actions are positive then the senders email will pass the filter

and be added to the list.

Regarding claim 2& 21, Malik teaches the method wherein sorting the display based on which of the senders are included in the list comprises sorting the display such that e-mails from identities on the list are grouped in one position of the display, **[Fig. 8, Ref # 812 & 814].**

Regarding claim 3 & 22, Malik teaches the method wherein sorting the display, based on which of the senders are included in the list comprises sorting the display such that e-mails from identities on the list are displayed and e-mails from identities not on the list are not displayed, **[Fig. 8, Ref # 812 & 814].**

Regarding claim 4 & 23, Malik teaches the method wherein sorting the display based on which of the senders are included in the list comprises sorting the display such that e-mails from identities on the list are not displayed and e-mails from identities on the list are not displayed, **[Fig. 8, Ref # 812 & 814].**

Regarding claim 6 & 25, Malik teaches the method wherein the positive actions include sending an e-mail to the entity, **[someone that the user knows, whether the e-mail is from a commercial vendor that has registered to send e-mail to the user, [(Column 1, lines 62 – 67)].**

Regarding claim 11 & 30, Malik teaches that the method further comprising: inferring

that a person is associated with the user based, at least in part, on detecting a

communication between the user and the person, **[Prior to presenting the e-mails to**

the user, the client sorts the e-mail into classifications based upon whether the e-

mail is from a personal contact, (Abstract)];

adding the inferred person to the list, **[storing a vendor registration code for the e-**

mail source; storing a vendor registration purpose code for the e-mail source,

(Column 10, lines 6 – 10) & (Fig. 6, Ref # 816)].

Regarding claim 13 & 32, Malik teaches that the method further comprising inferring that

a person is associated with the user and adding the person to the maintained list,

wherein inferring comprises: accessing a contact list of the user to determine a first

contact on the user's contact list, **[Fig. 7, Ref # 714]**;

and accessing a contact list of the first contact to determine a second contact on

the first contact's contact list, [Fig. 7, Ref # 714].

Regarding claim 14 & 33, Malik teaches that the method further comprising determining

that a person is associated with the user based, at least in part, on detecting user

actions that negate an inference that a person is associated with the user, **[Prior to**

presenting the e-mails to the user, the client sorts the e-mail into classifications

based upon whether the e-mail is from a personal contact, (Abstract)].

Regarding claim 15 & 34, Malik teaches the method wherein the user actions comprise

reporting a communication from the person as spam, **[E-mail users must sort through**

all of the SPAM in order to get to the e-mail that they desire to see, (Column 1,

lines 34 – 36)].

Regarding claim 16 & 35, Malik teaches the method wherein the user actions comprise

adding a person to a blacklist, **[Fig. 8, Ref # 814]**.

Regarding claim 17 & 36, Malik teaches the method wherein the user actions comprise

moving a communication from the person to either of a spam folder or a delete folder,

[Fig. 8, Ref # 812 & 814].

Regarding claim 18 & 37, Malik teaches that the method further comprising: enabling

the user to expressly designate a person as associated with the user, **[Fig. 7, Ref # 724**

& 732]; and adding the designated person to the list, **[storing vendor registration**

code for the e-mail source; storing a vendor registration purpose code for the e-

mail source, [(Column 10, lines 6 – 10) & (Fig. 6, Ref # 816)].

Regarding claim 19 & 38, Malik teaches the method wherein the people associated with

the user are people known to the user, **[The client sorts the e-mail into**

classifications based upon whether the e-mail is from a personal contact,

(Abstract)].

- Claims 12 & 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik et al. in view of Adkins et al. and further in view of Lewis et al. (US 2003/0110212).

Regarding Claims 12 & 31, Malik teaches a system for intelligently sorting e-mail comprises a client, which downloads e-mails from a server, **(See Abstract).**

Adkins et al. teaches an authorized email control system receives email destined for a particular user.

Adkins et al. differs from the claimed invention is that the communications are instant messages is not taught in Adkins et al.

Malik et al. differs from the claimed invention is that the communications are instant messages is not taught in Malik et al.

Lewis teaches a method for providing message information to a subscriber in a wireless network includes reading a cookie from a browser, modifying the cookie with the message information, transmitting the modified cookie to the browser, and displaying data to the subscriber based on the message information contained in the cookie, **(See Abstract)**, and further teaches that **[text messages including, for example, short messages, instant messages, and MOBITEX messages, enhanced messages, (Paragraph 0212)].**

Lewis provides the advantage of that the communications are instant messages.

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to modify Malik and Adkins by including that the communications are instant

messages as taught by Lewis.

One of ordinary skill in the art would have been motivated to make this

modification in order to provide the advantage of that the communications are instant

messages.

Conclusion

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeff Pwu can be reached on 571-272-6798.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

06/05/08

S. Taha

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2146